

REMARKS/ARGUMENTS

Upon entry of the present paper, the pending claims will have been amended for clarity only and submitted for reconsideration by the Examiner. In view of the above, Applicants respectfully request reconsideration of the outstanding rejections of the all claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants would like to express their appreciation to the Examiner for the detailed Official Action provided.

Applicants also note with appreciation the Examiner's acknowledgment of Applicants' Information Disclosure Statements filed in the present application on December 29, 2005 and January 11, 2006 by the return of the initialed and signed PTO-1449 Forms, and for consideration of the documents cited in the Information Disclosure Statements.

Turning to the merits of the action, the Examiner has rejected claims 12-18 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In setting forth the rejection, the Examiner asserts that "Claim, 12, 16 and 17 recites "...an IP address related to the receiving IP address". The nature of this relationship is a new matter that has not been described in the specification".

Initially, Applicants note that claims 12, 16 and 17 do not recite "...an IP address related to the receiving IP address", but recite "an IP address related to the receiving IP apparatus". Nevertheless, the nature of this relationship is explicitly supported by, for example, paragraphs [0042]-[0044] and [0049]-[0050] of the specification and Fig.3. Thus, Applicants respectfully request that the Examiner withdraw the rejection of claims 12-18 based upon 35 U.S.C. § 112, first paragraph.

In this regard, Applicants wish to make of record a telephone interview conducted on August 17, 2006, between Applicants' undersigned representative and the Examiner in charge of the present application. During the above-noted interview, the rejection of claims 12-18 under 35 U.S.C. § 112 was discussed. During the above-noted interview, the Examiner indicated that the scope of the claims, as amended in the previous response, was not clear to him. In particular, the Examiner indicated that the difference between "related to" and the previously utilized term "of" was unclear.

Based on this discussion, it appears that the Examiner's rejection is more appropriately set forth under 35 U.S.C. § 1.112, second paragraph. Nevertheless, and while Applicants, during the above-noted interview indicated that they do not agree with the Examiner's assertion that the term "related to" is indefinite, in order to eliminate this issue from consideration in the present application, Applicants have revised the claim language so as to recite "of" rather than to recite the term "related to". Applicants submit that this change does not in any significant fashion affect the scope of the claims. Nor does this change raise any new issues requiring further consideration or search. The change is made solely in order to address the Examiner's concerns as expressed during the above-noted interview regarding particular language incorporated into the claims by the previous response in the present application.

Accordingly, in view of the above-noted amendments and in view of the above-noted citation of explicit basis for the language of the claims in the original specification, it is respectfully submitted that the Examiner's basis for the rejection of any of the claims in the present application under 35 U.S.C. § 112, first or second paragraph has now been eliminated. An action to such effect is respectfully requested in due course.

The Examiner has rejected claims 12 and 15-17 under 35 U.S.C. § 102(e) as being anticipated by HUNA (U.S. Patent No. 6,944,273). The Examiner has also rejected claims 13 and 18 under 35 U.S.C. § 103(a) as being unpatentable over HUNA in view of RANALLI et al. (U.S. Patent No. 6,748,057). The Examiner has also rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over HUNA in view of GOODMAN (U.S. Patent No. 6,735,617).

However, Applicants respectfully traverse the above rejections.

As noted above, Applicants have not amended the scope of the pending claims in any substantial way but have submitted the same for reconsideration by the Examiner. Applicants respectfully traverse the above rejections based on claims 12-18 and will discuss these rejections with respect to the pending claims in the present application as will be set forth herein below.

Applicants' claims 12-15 and 18 generally relate to a server apparatus connected to a transmitting IP apparatus. The transmitting IP apparatus transmits an e-mail to a receiving IP apparatus via the server apparatus. The server apparatus comprises a memory which stores an IP address of the receiving IP apparatus in association with a telephone number of the receiving IP apparatus. The IP address of the receiving IP apparatus is distinct from an e-mail address. The server apparatus comprises a receiver which receives, from the transmitting IP apparatus, the e-mail. The e-mail includes the telephone number of the receiving IP apparatus.

The server apparatus further comprises an analyzer which obtains, from the received e-mail, the telephone number of the receiving IP apparatus, and obtains, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus. The receiving IP apparatus of the IP address is

identical to the receiving IP apparatus of the telephone number. The server apparatus further includes a transmitter that transmits the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus. Claim 16 recites a related system. Claim 17 recites a related method.

Regarding the rejection of claims 12 and 15-17 under 35 U.S.C. § 102(e), HUNA relates to an apparatus and method for entering and transmitting a message at a future delivery time to a receiving device that is coupled either to a telephony-centric network or to a data-centric network. In HUNA, the message server 402 (514) translates the message into a format compatible with the receiving device (520, 524, 528 and 532) and initiates delivery of the message at the future delivery time. For recipients having receiving devices connected to the telephony-centric network, the message server 402 (514) 1) embeds a telephone number of the receiving device (520, 524, 528 and 532) into the message and 2) routes the messages to an IP address of the local POP 408 (516) corresponding to the embedded telephone number (col.15, lines 52-60 and col.16, lines 53-58).

However, HUNA does not disclose at least a server apparatus that obtains, from the received e-mail, the telephone number of the receiving IP apparatus, and obtains, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number. Rather, HUNA obtains an IP address of the local POP 408 (516) corresponding to the embedded telephone number of the receiving device (520, 524, 528 and 532) (col.15, lines 52-60 and col.16, lines 53-58). As shown in Figs. 4 and 5, in HUNA, the local POP 408 (516) of the IP address is clearly different from the receiving device (520, 524, 528

and 532) of the telephone number. This feature of HUNA clearly contradicts this explicit recitation of Applicants' claims.

In setting forth the rejection, the Examiner asserts that the memory as recited in Applicants', e.g., claim 12, is disclosed by HUNA at column 15, lines 19-25 and lines 51-55. Applicants respectfully submit that this is incorrect. In this regard, Applicants note that the memory, as recited in, e.g., claim 12, is configured to store an IP address of the receiving IP apparatus in association with a telephone number of the receiving IP apparatus. It is respectfully submitted that while column 15, lines 19-25 of HUNA disclose that a recipient "can be aliased to several receiving addresses to include a telephone number, a pager number, fax number and e-mail address", it is clear that these refer to different devices as explicitly set forth at line 26.

Thus, while the present invention recites that the stored IP address and the telephone number that stored in association with the IP address, relate to "a receiving IP apparatus", it is clear that HUNA stores telephone numbers and addresses for different devices at which the recipient can be reached.

Yet additionally, while HUNA does disclose storage of an e-mail address, HUNA does not disclose an IP address. In this regard, Applicants memory defines the IP address as being distinct from an e-mail address. For these two additional reasons, it is respectfully submitted that Applicants' claim is distinct from the HUNA disclosure.

Furthermore, the Examiner's assertion that Fig. 7 shows the "To" field as indicating Richards' telephone number which is distinct from Richard's IP address is, not relevant to the recitations of Applicants' claim which recite the "IP address" being distinct from the "e-mail address". Fig. 7 of HUNA, at best, merely discloses that the

telephone number is distinct from the IP address, which is not what is recited in Applicants' claim.

Regarding the Examiner's reliance upon column 15, lines 51-55, for the memory recited in Applicants' claim 12, such reliance is also submitted to be misplaced. This portion of HUNA merely discloses that the server routes messages directed to the data-centric network directly to the IP address of a recipient. For those recipients having receiving devices connected to a telephony-centric network, the message router embeds the telephone number of a receiving device into the message along with the contact protocol for the receiving device and routes the message to the IP address of the local POP corresponding to the embedded telephone number. However, this portion of HUNA does not disclose a memory configured to store an IP address of the receiving IP apparatus in its association with the telephone number of the receiving IP address. Thus, for these additional reasons, Applicants respectfully submit that the HUNA reference is deficient with respect to the recitations of Applicants' claims.

In addressing the recited analyzer and transmitter, the Examiner asserts that these features are shown at column 15, lines 50-60. Applicants respectfully submit that the Examiner is incorrect. This portion of HUNA relates to the routing of messages designated for receiving devices. In this regard, receiving devices that are connected to the data-centric network 406 are routed directly to the IP address of a recipient. There is no indication in HUNA that a telephone number is utilized in such routing for devices connected to the data-centric network 406. On the other hand, for recipients having receiving devices connected to the telephony-centric network, a message router embeds a telephone number of a receiving device into the message, and routes the message to the IP address of the local POP 408 corresponding to the

embedded telephone number. This is not what Applicants' claim recites. Applicants' claim recites transmitting the e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus.

Furthermore, upon the local POP receiving the message, the message is transmitted via the telephony-centric network. In other words, the transmission is via telephone. Thus, according to HUNA, the transmitter does not transmit the received e-mail to the receiving IP address based on the IP address of the receiving IP apparatus, but rather based on the phone number. For these additional reasons, it is respectfully submitted that HUNA does not disclose the combination of features recited in Applicants' claims.

On the other hand, and in clear contrast to the above, the present invention recites an analyzer that obtains, from the received e-mail, the telephone number of the receiving IP apparatus, and obtains, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number.

In the Response to Arguments, the Examiner asserts that "*The Examiner respectfully submits that HUNA does not teach the server that the Applicants describe. It is a message server 402. The server 402 comprises an analyzer that is intelligent enough to take a message in text format, e-mail being one example, determine that it is going to a recipient having a voice-only receiving device, and use the translation logic and special-purpose software to translate the message text-to-voice (Col.15, lines 31-51)*". However, Applicants submit that this recited portion merely teaches that the message server 402 translates a message into a format compatible with a receiving

device, but does not teach a server including an analyzer that obtains, from the received e-mail, the telephone number of the receiving IP apparatus, and obtains, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number.

Even according to the Examiner's explanation of how he interprets the reference, while the local POP is "related to" the recipients phone number, it is not "the same", as recited in Applicants' claim. In this regard, Applicants again note that Applicants' claim explicitly recites that the receiving IP apparatus of the IP address being the same as the receiving IP address of the telephone number. This is clearly not true even in consideration of the Examiner's additional amplification of his position. In fact, the Examiner's amplification clearly emphasizes and admits the differences between the receiving IP apparatus of the IP address and the receiving IP apparatus of the telephone number. One understands that the POP server is clearly distinct from and not the same as, for example, the fax machine shown at 534 on Fig. 5 of HUNA.

In the sentence bridging pages 9 and 10 of the Official Action, the Examiner asserted that Applicants chose to disregard this passage and chose to focus on a special case. This is incorrect. Applicants note that the embedding of a telephone number is recited only for the so-called special case, which relates to recipients with receiving devices connected to the telephony-centric network. As noted previously and as set forth starting at line 52, messages designated for receiving devices connected to the data-centric network are sent directly to the IP address of a recipient. Such routing "directly to the IP address of a recipient" does not entail obtaining, from the received e-mail, the telephone number of the receiving IP address, as recited in

Applicants' claim. Thus, Applicants chose to refer to the recipients having receiving devices connected to the telephony-centric network which appears to teach embedding the telephone number of a receiving device into the message. However, as previously noted, this "special situation" has other deficiencies and drawbacks which precludes HUNA from properly being applied against the claims of the present application.

The Examiner also asserts that *"The message is then sent "directly to the IP address of a recipient" as stated word-for-word in line 54 of col.15 of HUNA. The Applicants chose to disregard this passage cited in the Office Action"*. As noted, this is incorrect.

As previously noted, in HUNA, messages designated for receiving devices connected to the data-centric network 406 are routed directly to the IP address of a recipient. On the other hand, for recipients having receiving devices connected to the telephony-centric network, the message router 1) embeds the telephone number of a receiving device into the message along with contact protocol for the receiving device, and 2) routes the message to the IP address of the local POP 408 corresponding to the embedded telephone number.

When messages designated for receiving devices connected to the data-centric network 406 are routed directly to the IP address of a recipient, the message server 402 merely translates the messages into formats compatible with the receiving devices. In other words, in this case, the message server 402 does not embed the telephone numbers of the receiving devices into the messages, and does not rely on the telephone numbers of the receiving devices to obtain the IP address of the receiving IP apparatus. Therefore, in the above case, HUNA does not disclose a server apparatus that obtains, from the received e-mail, the telephone number of the receiving IP

apparatus, and obtains, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number, as required by the pending claims.

On the other hand, for recipients having receiving devices connected to the telephony-centric network, the message router 1) embeds the telephone number of a receiving device into the message along with contact protocol for the receiving device, and 2) routes the message to the IP address of the local POP 408 corresponding to the embedded telephone number. However, in this case, the message server 514 (402) embeds the telephone number of the recipient into the message 534, and sends the message 534 to the IP address of the local POP 516 (col.16, line 53 - col.17, line 31). Then, the local 516 contacts the recipient using the embedded telephone number (col.17, lines 43-63). Thus, the local POP 408 (516) of the IP address is clearly different from the receiving device (520, 524, 528 and 532) of the telephone number. Therefore, HUNA does not disclose a server apparatus that obtains, from the received e-mail, the telephone number of the receiving IP apparatus, and obtains, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, "the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number", as required by Applicants' claim. Further, in this case, the local POP 408 (516) directs the local switch 454 (516) to call the receiving device over the telephony-centric network (col.15, lines 60-65) using the embedded telephone number of the receiving device (col.17, lines 43-63). Thus, in this case, HUNA does not disclose at least a server apparatus

including a transmitter configured to transmit the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus.

Thus, since HUNA does not comply with numerous of the recitations of the pending claims, the pending claims are clearly distinguished over HUNA.

Therefore, it is respectfully submitted that the features recited in Applicants' submitted claims 12 and 15-17 are not disclosed in HUNA cited by the Examiner.

Regarding the rejection of claims 13 and 18 under U.S.C. § 103(a) as being unpatentable over HUNA in view of RANALLI et al, as discussed above, HUNA does not disclose at least a server apparatus that obtains, from the received e-mail, the telephone number of the receiving IP apparatus, and obtains, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number.

RANALLI et al. relates to an IP-PBX system that accepts a telephone number as a destination address, contacts a directory server, requests an IP address related to the telephone number and returns the IP address to the IP-PBX system (col.7, lines 51-67 and col.8, lines 1-18).

However, RANALLI et al. does not disclose at least an analyzer apparatus that obtains, from a received e-mail, the telephone number of the receiving IP apparatus, and obtains, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number. Rather, RANALLI et al. merely teaches that an IP-PBX system contacts the directory server to request the IP address related to the telephone number and returns the IP

address to the IP-PBX system. Thus, RANALLI et al. does not contain any disclosures regarding a server that includes an analyzer that obtains, from the received e-mail, the telephone number of the receiving IP apparatus.

Further, RANALLI et al. does not disclose at least a transmitter that transmits the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus. Rather, in RANALLI et al. the directory server merely returns the IP address to the IP-PBX system that has accessed the directory server. Thus, RANALLI et al. does not contain any disclosure regarding a transmitter that transmits the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus.

On the other hand, the present invention recites an analyzer that obtains, from the received e-mail, the telephone number of the receiving IP apparatus, and obtains, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number and a transmitter that transmits the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus.

Thus, the pending claims are clearly distinguished over RANALLI et al. and HUNA, regardless of whether RANALLI et al. discloses error notification. Moreover, the Examiner has not set forth any motivation for the proposed combination aside from the assertion that HUNA and RANALLI et al. are analogous art. In this regard, Applicants note that motivation must constitute some suggestion, incentive or other basis for the proposed combination, not merely the Examiner's assertion that two patents come from analogous fields.

Regarding the rejection of claim 14 under U.S.C. § 103(a) as being unpatentable over HUNA in view of GOODMAN, as discussed above, HUNA does not disclose at least a server apparatus that obtains, from the received e-mail, the telephone number of the receiving IP apparatus, and obtains, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number.

GOODMAN relates to a system in which, when the sender's computer 920 sends a facsimile message to the recipient's facsimile machine 975, the facsimile message is sent from the sender's computer 920 to the sender's mail server 930. An address of the recipient's facsimile machine 975 includes a telephone number of the recipient's facsimile machine 975 and a domain name of the facsimile mail server 950. The sender's mail server 930 obtains an IP address of the facsimile mail server 950 from the DNS server 945, based on the domain name of the facsimile mail server 950. The sender's mail server 930 forwards the facsimile message to the facsimile mail server 950, based on the IP address of the facsimile mail server 950. The facsimile mail server 950 selects a gateway to which the facsimile message should be forwarded and forwards the facsimile message to the selected gateway. The gateway is selected, based on loads on different gateways at a time when the facsimile communication is forwarded. Ultimately, the facsimile message is delivered from the selected gateway to the recipient's facsimile machine 975 over a "conventional telephone network" 970 (col. 6, lines 54-67 and col. 7, lines 1-33).

However, in GOODMAN, a telephone number "1112223333" is assigned to recipient's facsimile machine 975 (col.6, lines63-67), but an IP address is not assigned

to the recipient's facsimile machine 975. The telephone number "1112223333" assigned to the recipient's facsimile machine 975 is a conventional telephone number (col.6, lines 38-46). In other words, GOODMAN does not contain any disclosure regarding an IP address of the recipient's facsimile machine 975. Thus, in GOODMAN, a facsimile message is forwarded from the VOIP Outbound Gateway 956 to the recipient's facsimile machine 975 over the conventional telephone network 970, using the telephone number "1112223333" of the recipient's facsimile machine 975.

Further, an address, for example, "1112223333@faxservername.xxx" is utilized for forwarding a facsimile message to the recipient's facsimile machine 975. The address consists of the conventional telephone number of the recipient's facsimile machine 975 and a name of the facsimile mail server 950 (col.6, lines 38-46 and col.7, line 15). In other words, the address does not include an address of the VOIP Outbound Gateway 956. Thus, GOODMAN does not contain any disclosure regarding a telephone number of the VOIP Outbound Gateway 956.

Thus, GOODMAN does not disclose a H.323 gatekeeper which stores the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, since GOODMAN does not contain any disclosure regarding an IP address of the recipient's facsimile machine 975 or a telephone number of the VOIP Outbound Gateway 956. GOODMAN also does not disclose an analyzer which determines whether the memory stores the IP address of the receiving IP apparatus. Further, GOODMAN does not disclose a transmitter which accesses the H.323 gatekeeper to obtain the IP address of the receiving IP apparatus when it is determined that the memory does not store the IP address of the receiving IP apparatus.

Additionally, Fig. 13 of GOODMAN shows a gatekeeper lookup table which contains zones, gateway addresses, and gateway priority. However, none of these teach an IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus.

Thus, GOODMAN does not comply with the recitations of claim 14, so this pending claim is thus clearly distinguished over GOODMAN and HUNA.

Again, as noted above, the Examiner has not set forth any basis or motivation for the combination of the teachings of GOODMAN and HUNA. The Examiner's mere assertion, even if true, that GOODMAN and HUNA are analogous arts, does not provide the suggestion required for a proper motivation under 35 U.S.C. § 103.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections, and an indication of the allowability of all the claims pending in the present application, in due course.

SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have amended the rejected claims to overcome the 35 U.S.C. § 112 rejection and requested reconsideration by the Examiner.

With respect to the pending claims, Applicants have pointed out the features thereof and have contrasted the features of the rejected claims with the disclosure of the references. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully request an indication of the allowability of all the claims pending in the present application in due course.

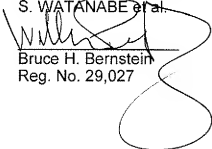
The undersigned hereby authorizes the U.S. Patent and Trademark Office to charge any fees necessary to maintain the pendency of the above-identified application, including any extension of time fees to Deposit Account No. 19-0089.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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